REMARKS

Applicant responds to the December 11, 2008 Office Action with the following remarks presented according to the Examiner's communication.

Status of Claims

Claims 1 – 5, 7 – 9, 11 - 15 and 17 – 19 are pending in this application. Claims 1 and 11 are herewith amended. Support for the amendments is found throughout the specification. No new matter is presented by the amendment. Accordingly, Applicant respectfully requests entry thereof, and reconsideration of claims 1 – 5, 7 – 9, 11 - 15 and 17 – 19 in light of the above amendments and the following remarks.

Claim Rejections – Rejection under 35 U.S.C. § 101

Claims 1 – 5, 7 – 9, 11 – 15 and 17 – 19 have been rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. This rejection is respectfully traversed. The rejections against the pending claims under consideration should be withdrawn for at least the reasons set forth below.

The Examiner rejects the claims for failing to meet the standard machine-or-transformation test under *In re Bilski*. However, Claims 1 and 11 have been amended to, *inter alia*, recite a method and system tied to a special purpose computer. In particular, Claims 1 and 11 recite storing product parameter data and a pricing algorithm on a data storage device such that the product parameter data is accessible to the user by an online interface device on a network. *See* U.S. Pat. Pub. No. 20001/0047312 at Paragraph [0032] ("user may access the method and system of the present invention by logging into the system.") The product parameter data is pulled from the data storage device and representations of the product parameter data are

presented to a user through a graphical user interface (GUI) *Id.* ("Items and processes may then be searched and matched based on materials or other specifications and stored in a data base."). The user can then designate the features of a branded product by selecting product parameter data represented by the GUI. *Id.* at Para. [0035] ("At step 212, a user may create an item definition page by using an item template for the selected item category."); *Id.* at Para. [0038] ("[C]olors may be identified and/or selected from a list of available colors/patterns [and] material . . . may be identified and/or selected from a list of available materials"); *see also* Fig. 4 (illustrating the product selection step 212 and the dropdown menus and checkboxes displayed to the user over the GUI). The user can later retrieve, access, and edit previous projects by utilizing the dropdown menu displayed over the GUI. *Id.* at Para. [0040]; *see also* Fig 5 (depicting said menu screen with dropdown menus). The invention also allows a user to upload a digital image to be incorporated into the desired product, which is done using the special-purpose computer. *Id.* at Para. [0050]; *see also* Fig 11. The user is guided through the product selection process by the pricing computer through the graphical interface as it displays subsequent screens with dropdown menus giving additional parameters to select from. (*Id.* at Para. [0041]; Figs 6a & 6b); *Id.* at Para. [0044] ("Selecting a process category takes the user to an associated process template page for that category.").

Similarly, pricing the product is tied to a special purpose computer. After designating the desired product parameters as described above, a unique request is created and is transmitted back to the pricing computer over the network. The pricing computer then applies the appropriate pricing algorithm from the data storage device, based on the pricing matricies input by the administrator. *Id.* at Para. [0044] (Describing pricing matricies applied to selected

product); *Id.* at Para. [0047] (Describing how the "pricing matricies may vary according to the type of process and specifications made by the administrator.") The pricing computer then applies the pricing algorithm to derive the price of the requested item. This price is then transmitted back over the network to be viewed by the user over the GUI. *See* Figs 10a & 10b (illustrating product selection summary with pricing information).

Likewise, a special purpose computer is also used to generate a unique identifier for the product. The computer dynamically links the item parameters, the process parameters and the artwork parameters to dynamically generate a product identifier. This product identifier is unique to the parameters of that particular product, and is transmitted back to the user from the special-purpose computer to the GUI. *Id.* at Para. [0051] (discussing applying a CG number to the product); Figs 12a & 12b (illustrating product process edit page wherein a CG number has been generated for the product and displayed over the GUI).

Accordingly, Claims 1 – 5, 7 – 9, 11 - 15 and 17 – 19 recite statutory subject matter. Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

Claim Rejections - Rejection under 35 U.S.C. § 103

Claims 1 and 11 have been rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 6,493,677 to von Rosen ("Rosen") in view of Bittel, Lester Robert (Ed.), Encyclopedia of Professional Management, ISBN 0-07-005478-9, pp. 739 and 958 (1978) ("Bittel"). This rejection is respectfully traversed. The rejections against the pending claims under consideration should be withdrawn for at least the reasons set forth below. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the

prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Among other things, Rosen in view of Bittel fail to disclose all of the recited elements of independent claims 1 and 11.

Rosen in view of Bittel do not teach nor suggest a computer implemented method for configurating one or more products where products may be divided into items and processes, wherein item and process parameters may be separately specified and linked together to create a unique product where a product identifier may be dynamically created when the product is sourced, quoted, ordered or otherwise accessed (*see* Paragraph [0031]). Moreover, neither Rosen nor Bittel teach a method of storing product parameter data and a pricing algorithm on a data storage device such that the product parameter data is accessible by an online interface device on a network such that a user can designated features of the product by selecting product parameter data represented by a GUI.

In contrast, independent claims 1 and 11 are directed to a computer implemented method and system for configuring one or more products where products may be divided into items and processes ***wherein item and process parameters may be separately specified and linked together to dynamically create a unique product identifier when the product is sourced, quoted, ordered or otherwise accessed***. Moreover, the independent claims teach ***storing product parameter data and a pricing algorithm on a data storage device such that the product parameter data is accessible by an online interface device on a network,*** and ***presenting a graphical user interface (GUI) for displaying representations of the product parameter data*** such that a ***user designates features of the product by selecting product parameter data represented by the GUI***. Further, claims 1 and 11 recite that the product identifier ***is defined by***

a combination of the product's item parameters, process parameters, and artwork parameters. These claimed features, among others, are completely missing in Rosen in view of Bittel.

First, Bittel's teachings do not suggest or contemplate the manner of computer usage for product identification disclosed in the current invention. Bittel is a reference that is over 30 years old and thus is limited by its age as to what it perceives to be computer usage. It does mention computer usage in inventory management but its discussion is limited to storing a mere *data bank* of inventory amounts and balances (Bittel, 740 left col.). This inventory management structure is clearly regarded as a separate entity from the parts-numbering system discussed in Bittel. ("When used in combination with a . . . communicative parts numbering system, the inventory management structure becomes a keystone of the materials management system." Id.) In contrast, the present invention utilizes a computer and computer-based algorithm to not only create the product identification (or parts number) but does so in a manner that reflects the particular aspects and features of the product. Furthermore, the present invention teaches storing product parameter data and a pricing algorithm on a data storage device such that the product parameter data is accessible by an online interface device on a network, and presenting a graphical user interface (GUI) for displaying representations of the product parameter data such that a user designates features of the product by selecting product parameter data represented by the GUI. In no way does Bittel teach suggest or otherwise show motivation to computerize the way products are identified.

Second, Rosen appears to describe a system whereby a *single static price* is applied to the cost of a product *regardless* of what image or artwork is actually used. There is no discussion of price or of how a price is derived in von Rosen's specification. In contrast, Claims 1 recites

"dynamically generated using user-customizable pricing data and formulas based in part on the item, process, and artwork parameters." The present invention has the advantage of providing a user with pricing information that takes into account a large multitude of factors including, e.g., the desired materials to be used, the actual item to be customized, the nature of the stitching, and even the size and complexity of the artwork (*see, e.g.,* Paragraph [0029]). This provides the consumer with an exact price for their product based upon the nearly infinite possible combinations of product, process and materials. Further, the invention cuts out the "middle man" by allowing the consumer to interact directly with manufacturers.

Third, if one skilled in the art combined the teachings of Rosen with Bittel, the end result would be a system that included nothing more than a markup of the static price of Rosen's product. Independent claims 1 and 11 require ***linking identified item parameters, process parameters and artwork parameters to dynamically create a product identifier when the product is sourced, quoted or ordered.*** Claims 1 and 11 further recite that the product identifier is defined by ***a combination of the product's item parameters, process parameters, and artwork parameters***. The disclosure of Rosen provides no discussion of product identifiers. Rosen is directed to creating and ordering customized branded merchandise but fails to provide any meaningful discussion of product identifiers that relates in any way to the claimed dynamic creation of a product identifier when the product is sourced, quoted, or ordered. The Examiner relies primarily on Bittel to show that "would have been obvious to a person of ordinary skill in the art to have applied known pricing and inventory management practices to von Rosen. . .," (Office Action at 5). Bittel does states that "one of the key materials management issues concems itself ***with the problem of parts and materials standardization***," (Bittel at p. 739).

However, Bittel does not teach nor suggest any solution to this problem, nor how to create a "good parts numbering system" in relation to customizable products. Bittel merely points out the problem—not the means for solving it.

Moreover, as set forth in the declarations of David and Lynne Verchere, it is well beyond the ability of one skilled in marketing to combine the process discussed in Rosen with the general statement in Bittel to arrive at the present invention. The Examiner improperly declined to consider these two declarations filed by the Applicant on November 7, 2008 pursuant to 37 CFR 1.132. Instead of considering the declarations as evidence of the present invention's non-obviousness, the Examiner maintained that the declarations could not rebut a *prima facie* finding of obviousness because they did not contain reference secondary considerations, citing *Stratoflex, Inc. v. Aeroquip Corp.,* 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). The Examiner's assertion is incorrect. In particular, the Examiner relied on *Stratoflex* for the erroneous proposition that evidence of secondary considerations is the *only* type of evidence sufficient to rebut a *prima facie* case of obviousness. While it is true that secondary evidence of non-obviousness must always be considered *when present,* it is "**inappropriate to disregard any relevant evidence on any issue in any case, patent cases included.**" *Stratoflex* at 1538 (emphasis added). Contrary to the Examiner's position, these declarations must be considered because they: (1) establish the level of a person of ordinary skill in the art; and (2) show that a person of ordinary skill in the art would not be motivated to combine the teachings of Von Rosen and Bittel.

Contrary to the Examiner's statements, the Verchere declarations evidence the level of ordinary skill of a person in the art, as well as the nonobviousness of the present invention. The

Examiner's failure to consider the declarations is improper in light of the Federal Circuit's mandate in *Sullivan.* Indeed, "[w]hen a patent applicant puts forth rebuttal evidence, the [PTO] must consider that evidence." *In Re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007) (citing *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995) (stating that "all evidence of nonobviousness must be considered when assessing patentability").)

The present invention incorporates several key features, including computer implemented system accessible over a network having a pricing algorithm and product-identification generator. These features allow the user, possessing the ordinary skill of a marketer/promoter, to be able to obtain remarkably accurate pricing data without having to be an expert in the field of materials management and/or advanced economics. Notwithstanding the shortcomings of the Bittel reference discussed previously, the Verchere declarations show it is well beyond the grasp of one skilled in marketing to combine the process in Rosen with the general statement in Bittel to arrive at the present invention.

The Office Action implies that a person of ordinary skill in the art of the invention is someone possessing expertise in all areas of materials management as well as marketing and business administration. This broad interpretation ignores the intended user and the core purpose of the invention: to provide a valuable bridge between marketing personnel and the manufacturers of promotional goods as set forth in the declaration. The present invention incorporates several key features that allow the user, possessing the ordinary skill of a marketer/promoter, to be able to obtain remarkably accurate pricing data without having to be an expert in the field of materials management and/or advanced economics. Here, it is well beyond

the skill of a marketer to be able to apply the requisite advanced business skills and supply-chain knowledge to arrive at a solution to the pricing and inventory problems outlined in Bittel.

Moreover, as set forth in detail in the Rule 132 Declaration of David Verchere submitted herewith, the claimed invention is nonobvious because it enjoys commercial success. When analyzing whether alleged prior art references render claims invalid as obvious, the Examiner ***must consider*** objective indicia that would indicate the nonobviousness of the claimed inventions including, for example, the commercial success of the claimed inventions, whether the inventions filled a long-felt but unsolved need in the field, evidence of copying, and initial skepticism of others in the field, among other factors. *See In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007); MPEP 716.

As an expert in the field, Mr. Verchere's declaration is persuasive evidence which the Examiner must consider. Mr. Verchere's declaration describes in detail numerous examples of promotional product industry members who incorporated the claimed invention into their systems for branding promotional products. For example, Mr. Verchere's declaration offers objective evidence of the industry's acceptance of the claimed invention, as shown by (a) incorporation of the claimed invention into at least fourteen different systems made and sold by industry members; (b) replacement of earlier products such as "online brochures" of promotional products; and (c) copying. Moreover, Mr. Verchere states, *inter alia*, that based upon publicly available information and his many years of industry experience, there is a nexus between the claimed invention and the commercial success of the recited systems, and such nexus is due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the patented subject matter.

Accordingly, since Rosen in view of Bittel fail to disclose the recited elements of independent claims 1 and 11, and there exists objective evidence of the claimed invention's nonobviousness, Applicant respectfully requests the Examiner to withdraw this rejection.

Dependent claims 2 – 5, 7 – 9, 12 – 15 and 17 – 19 are Each Separately Patentable over Rosen in view of Bittel

The remaining claims depend ultimately from independent claims 1 and 11, as such, contain the features recited in claims 1 and 11. As discussed above, the proposed combinations fail to suggest or disclose each feature recited in the independent claims and, therefore, also fails to suggest or disclose at least these same features in the dependent claims. For at least this reason, Applicant respectfully submits that the rejections of the pending claims are improper and request that they be withdrawn. Additionally, these claims are separately patentable over the proposed combination of references for at least the reasons stated above.

Conclusion

In view of the foregoing, Appellant respectfully requests that the Examiner withdraw the prior art rejections set forth in the Office Action and allow all of the pending claims.

Respectfully submitted,

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